UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GEORGES SMITS, and LEEN DE LEENHEER

Appeal No. 2007-1028
Application No. 09/600,732

REMAND TO THE EXAMINER

Before SCHEINER, ADAMS, and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issue and to take appropriate action.

This is the second time this application is before this panel. In the first appeal (Appeal No. 2004-1498) we reversed the rejection of claims 65-70, 72-78, and 89-97 under 35 U.S.C. § 103 as being unpatentable over Yamazaki[1] in view of Van Den Ende[2]; and the rejection of claims 79-88 under 35 U.S.C. § 103 as

[1] Yamazaki et al. (Yamazaki) 4,613,377 Sep. 23, 1986

[2] Van Den Ende et al. (Van Den Ende), "Fructan Synthesizing and Degrading Activities in Chicory Roots (Cichorium intybus L.) during Field-growth, Storage and Forcing," Plant Phys., Vol. 149, pp. 43-50 (1996)

being unpatentable over Yamazaki in view of Van Den Ende and Van Loo[3]. See Decision, mailed July 28, 2004.

In response to the Decision, the examiner reopened prosecution, introduced a new reference (IRM[4]) and rejected all pending claims over this new reference in combination with Yamazaki and Van Den Ende with or without Van Loo. Specifically,

> Claims 65-70, 72-78, and 89-97 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamazaki in view of Van Den Ende and IRM; and
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> Claims 79-88 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamazaki in view of Van Den Ende, IRM and Van Loo.

Apparently the examiner is of the opinion that IRM provides the evidence missing from the original combination of Yamazaki and Van Den Ende with or without Van Loo. Thus, it goes without saying that IRM may be a very critical evidentiary document. The problem, however, is that IRM is a foreign language document and the examiner has failed to favor this record with a translation of this foreign language document. Obviousness determinations are fact-intensive. It stands to reason that English language translations of foreign language documents will provide more facts.

We recognize appellants' assertion that all four of the references cited above, including the IRM document were of record in Appeal No. 2004-1498. Brief, page 14. According to appellants the IRM "temperatures were specifically rejected as speculative for the town of Heverlee where the Van Den Ende et al.

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[3] Van Loo et al. (Van Loo) 5,660,872 Aug. 26, 1997

[4] Institute Royal Meteorologique de Belgique (IRM), Temperature data, pages 1-2, 1994.

studies were conducted." Id. We disagree with this characterization our Decision. To begin, the IRM was made of record by the examiner for the first time on July 8, 2005 – almost one year after our Decision. See Form-892, mailed with the July 8, 2005 Office Action.

For clarity we note that the bridging paragraph of pages 11-12 of our Decision states "we find no reference before us on this appeal that provides an evidentiary basis to support the examiner's assertion the temperature in Heverlee, Belgium did not fall below 1°C during the time period at which Van Den Ende performed their study." While appellants make reference to a "printout of weather conditions from Brussels, Belgium" which the examiner allegedly attached to the October 20, 2003 Advisory Action, the electronic file wrapper contains no such attachment, and the March 4, 2004 Answer did not rely on this document. Accordingly, this panel stated that

> to the extent that the examiner would have relied on a "printout of weather conditions for Brussels, Belgium allegedly to show that growing conditions in Belgium for the time period reported in Van Den Ende et al. did not fall below 1°C," see Brief, page 15; as appellants point out (id), "[t]he [e]xaminer has failed to establish prima facie that the temperature conditions in Heverlee [the locus of the Van Den Ende's study]... would be the same as the temperature conditions [in] Brussels."

The examiner now appears to rely on IRM to provide this missing evidence. See Answer, bridging paragraph, pages 5-6, which states IRM "indicates that the temperatures never dropped below minus 1°C, except for two days in December, 1994 (. . . these two days are out of the growing and processing period of Van Den Ende et al. . .)."

Upon receipt of the application, the examiner should obtain an English language translation of the IRM document. If upon review of this

document, the examiner remains of the opinion that the claims on appeal are unpatentable, the examiner should issue an appropriate Office action which sets forth the facts and reasons used in support of such a rejection. Any further communication from the examiner which contains a rejection of the claims should provide appellants with a full and fair opportunity to respond.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01 (7th ed., rev. 1, February 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Toni R. Scheiner)
Administrative Patent Judge)
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